

REMARKS

This amendment responds to the office action mailed April 9, 2003. In the office action the Examiner:

- objected to the specification for including certain informalities;
- rejected claims 1, 5-8, 12-15, and 19-21 under 35 U.S.C. 102(b) as anticipated by Peercy *et al.* (US Patent No. 5,960,429);
- rejected claims 22-24, 26-27, and 29-30 under 35 U.S.C. 102(e) as anticipated by Getchius *et al.* (US Patent No. 6,408,294 B1);
- rejected claims 2-4, 9-11, and 16-18 under 35 U.S.C. 103(a) as being unpatentable over the teachings of Peercy *et al.*, as applied to the rejection of claims above, in view of Getchius *et al.*; and
- rejected claims 24, 25, 28, and 31 under 35 U.S.C. 103(a) as being unpatentable over the teachings of Getchius *et al.*, as applied to the rejection of claims above, in view of Peercy *et al.*

After entry of this amendment, the pending claims are: claims 1-36. The specification has been amended to correct grammatical errors. With this amendment, claims 1, 7, 8, 14, 15, and 21 have been amended to disclose that a set or plurality of lists is received from remote web services. Claims 22, 26, and 29 have been amended to require that the selected web service be a remote web service. Claims 4, 11, 18, 22, 26, and 29 have been amended to emphasize that the selected remote web service generates data in response to the query. Claims 2-4, 9-11, 16-18, 25, 28, and 31 have been amended for clarity. Claims 32 and 33 have been added to more particularly recite certain features of the claimed invention. Claims 34-36 are broadened versions of amended claims 22, 26 and 29. No new matter has been added.

AMENDMENT TO SPECIFICATION

With this Amendment, Applicants have amended the specification to remove the phrase "well know" in favor of "well known". Accordingly, Applicants request that the objection be withdrawn.

THE REJECTIONS UNDER 35 U.S.C. 102(B) AND (E) SHOULD BE WITHDRAWN

The Examiner rejected claims 1, 5-8, 12-15, 19-21, 22-24, 26-27, and 29-30 under 35 U.S.C. 102(b) and (e) as being anticipated by Peercy *et al.* and Getchius *et al.* The Examiner asserts that Peercy *et al.* recites each and every element of claims 1, 5-8, 12-15, and 19-21 of the instant application, and that Getchius *et al.* recites each and every element of claims 22-24, 26-27, and 29-30 of the instant application. Applicants respectfully traverse these rejections.

Legal Standard. To anticipate a claim, a reference must teach every element of the claim (see § 2131 of The Manual of Patent Examining Procedure, Original Eighth Edition, August 2001, Revised February 2003). Anticipation requires that all the elements and limitations of the claim be found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosed, as viewed by a person of ordinary skill in the art in the field of the invention. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Peercy *et al.* does not teach each element of claims 1, 5-8, 12-15, and 19-21.

Independent claims 1, 7, 8, 14, 15, and 21 as amended disclose the use of *lists from remote web services*, the distillation of these lists into databases or sorted lists *organized by searches submitted*, and the *matching of entries in these databases or sorted lists to queries*. Peercy *et al.* does not teach or suggest these limitations.

Peercy et al. does not teach the receipt of lists from remote web services. Claims 1, 7, 8, 14, 15, and 21, as amended, recite that a set or plurality of lists are received from remote web services. As is described on page 6, lines 8-17 of the specification, participating web services, including “engines such as CNET’s Shopper.com and Amazon.com’s Lawn & Patio Store,” send in lists to be aggregated into a database or sorted list. Peercy *et al.*, does not receive such lists. Peercy *et al.* teaches a single search engine that maintains a history log database that keeps track of the URLs requested and the number of times each URL was requested. When, instead of requesting a particular URL, a user requests the most frequently visited URLs, a multiple reference hotlist (composed of the entries in the history log database with the highest tallies) is displayed to the user. (Peercy *et al.*, col. 4, lines 30-47.) The history log database of Peercy *et al.* differs from claims 1, 7, 8, 14, 15, and 21 of the instant application because the history log database does not receive data from any remote web

service (for example, another search engine). Instead, the history log database receives data from the same search engine that maintains the database.

Also, Peercy's history log is for a single search engine, which means that Peercy et al. also does not "distill" multiple lists from diverse sources into a database, as required by these claims.

Peercy et al. does not teach a database or sorted list organized by searches submitted. Claims 1, 7, 8, 14, 15, and 21 recite that the received lists are distilled into a database or sorted list that indicates, per each search submitted, the web services to which the search was submitted, and the frequency of such submissions. Page 12, lines 17-20, and page 4, lines 1-11, of the specification describe a record of a frequency database and an entry of a frequency sorted list as claimed. A submitted query is thus included in both the frequency database records and the frequency sorted list entries. Peercy et al. does not include submitted queries (searches) in its history log database. Peercy et al. only requires the history log database to "accumulate the total number of retrievals made of any number of different web pages." (Peercy et al., col 2, lines 57-58.) As described in Peercy et al., the history log database includes URLs and the number of times each URL has been visited, but does not include the searches submitted to the URLs, nor the number of times the searches were submitted to each URL.

Peercy et al. does not teach searching a database or sorted list for matches between a search in the database and a query. Claims 1, 7, 8, 14, 15, and 21 recite that a query is obtained and a frequency database or sorted list is analyzed to find searches that match the query. The web services in the records or entries associated with the matching searches that have the highest frequencies are then selected for use in directed content. (Specification, page 4, lines 7-11.) Peercy et al. does not teach such an analysis of the history log database. When a multiple reference hotlist is requested, one or more records from the history log database are retrieved and presented to the user. (Peercy et al., col. 5, lines 25-36.) The records retrieved depend on factors (e.g., a "cutoff value", "popularity score") that do not include matching searches. (Peercy et al., col. 4, lines 49-52, and col. 3, lines 8-16.)

For the reasons discussed above, claims 1, 7, 8, 14, 15, and 21 are not anticipated by Peercy et al., and are thus patentable. Claims 5, 6, 12, 13, 19, and 20 depend from one of claims 1, 8, and 15, and are therefore patentable for at least the same reasons that claims 1, 8, and 15 are patentable over the cited art. Thus, Applicants respectfully request that the rejection to claims 1, 5-8, 12-15 and 19-21 be withdrawn.

Getchius *et al.* does not teach each element of claims 22-24, 26-27, and 29-30.

Getchius et al. does not teach routing a query to and receiving a response from a remote web service. Claims 22, 26, and 29, as amended, disclose communication between a remote web service including routing a query to the web service and then receiving a response generated by the web service upon presentation of the query. (Specification, page 3, lines 28-32.) *Getchius et al.* does not communicate with a remote web service. *Getchius et al.* recites an online query tool that includes a request router and several server nodes. When the request router receives a request from the user, it routes the request to an available server node. (*Getchius et al.*, col. 4, line 56, to col. 5, line 14; and col. 11, lines 13-26.) The request is thus routed to a server node within the same web service, and not a remote web service as recited in claims 22, 26, and 27.

The distinction between local and remote web services is significant in the context of the claims in question. In *Getchius et al.*, the multiple servers shown in Figure 2 are described as being part of a single front end server. These servers are part of a single, unified system, while the method, computer program product and system of claims 22, 26, 29 select and then collect information from a remote service. Selecting and then retrieving information from remote services enables access to a wider diversity of information, including information that has been collected through the efforts of others, while *Getchius et al.* only retrieves information from within a closed system.

Getchius et al. does not teach including, in a directed advertisement, a portion of a response generated by a remote web service upon presentation of a query. Claims 22, 26, and 29, as amended, recite that a portion of the response generated by the remote web service upon presentation of a query is included in a directed advertisement. (Specification, page 15, lines 8-13.) *Getchius et al.*, however, does not recite using such a response. *Getchius et al.*, as explained above, does not communicate with a remote web service in responding to a query. The response in *Getchius et al.* is based upon data already existing in the online query tool's databases. Unlike claims 22, 26, and 29, which recite including a portion of the response generated by a remote web service that is selected upon presentation of a user's query, *Getchius et al.* only uses existing data (i.e., data stored by a local web service), and the source of the data (i.e., which web service is used to obtain the data) in *Getchius* is not based on the query being processed.

Since *Getchius et al.* does not teach or suggest communication with a remote web service in responding to a user's query, or the use of a remote web service's response that is

generated upon presentation of the user's query, as recited in claims 22, 26, and 29, Getchius *et al.* does not teach each element of claims 22, 26, and 29. Accordingly, claims 22, 26, and 29 are not anticipated by Getchius *et al.*, and are thus patentable. Claims 23, 24, 27, and 30 depend upon claims 22, 26, and 29, and are also patentable for at least the same reasons claims 22, 26, and 29 are patentable over Getchius *et al.* Accordingly, Applicants respectfully request the 35 U.S.C. § 102 rejection of claims 22-24, 26-27, and 29-30 be withdrawn.

New claims 34-36. New claims 34-36 are similar to claims 22, 26 and 29, respectively, except that these new claims directly call for selection of a remote web site based on a received query, instead of (as required by claims 22, 26, 29) basing the selection of a remote web site on an element of a web resource that is determined based on a search of the web resource. Since none of the points discussed above regarding why claims 22, 26 and 29 are patentable over Getchius *et al.* depend on the "searching a web resource" aspect of claims 22, 26, 29, claims 34-36 are patentable over the prior art of record for the same reasons as claims 22, 26, 29.

THE REJECTION UNDER 35 U.S.C. 103(A) SHOULD BE WITHDRAWN

The Examiner rejected claims 2-4, 9-11, 16-18, 24-25, 28, and 31 under 35 U.S.C. 103(a) as being unpatentable over the combination of Peercy *et al.* and Getchius *et al.* The Examiner states that Peercy *et al.* differs from claims 2-4, 9-11, and 16-18, but that this difference does not exist when Peercy *et al.* is combined with Getchius *et al.* The Examiner also states that Getchius *et al.* differs from claims 24-25, 28, and 31, but that this difference does not exist when Getchius *et al.* is combined with Peercy *et al.* The Applicant respectfully traverses these rejections.

Legal standard. To reject claims in an application under 35 U.S.C. § 103, the PTO bears the initial burden of establishing a prima facie case of obviousness. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). In order to establish prima facie obviousness, three basic criteria must be met. First, the prior art must provide one of ordinary skill in the art with a suggestion or motivation to modify or combine the teachings of the references relied upon by the PTO to arrive at the claimed invention. *WMS Gaming Inc. v. International Game Technology*, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). Second, the prior art must provide one of ordinary skill in the art with a reasonable expectation of success. See *In re O'Farrell*, 7 USPQ2d 1673 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531

(Fed. Cir. 1988). Third, the prior art, either alone or in combination, must teach or suggest each and every limitation of the rejected claims. See *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Royka and Martin*, 180 USPQ 580 (C.C.P.A. 1974); and *In re Wilson*, 165 USPQ 494 (C.C.P.A. 1970). If any one of these criteria are not met, prima facie obviousness is not established.

In the present instance, a relevant inquiry is whether the cited art, either alone or in combination, teaches each and every limitation of the rejected claims. As discussed in detail below, the cited art fails to satisfy this requirement. Therefore, the rejection should be withdrawn.

The combination of Peercy *et al.* and Getchius *et al.* does not teach or suggest every limitation of claims 2-4, 9-11, and 16-18.

Claims 2-4, 9-11, and 16-18 all depend from claims 1, 8, or 15. As discussed in the response to the U.S.C. § 102, rejections above, Peercy *et al.* fails to disclose (i) the receipt of lists from remote servers, (ii) a database or sorted list organized by searches submitted, or (iii) searching a database or sorted list for matches between a search in the database and a query. Getchius *et al.* does not even communicate with a remote web service and, as such, does not remedy any of the shortcomings of Peercy *et al.* For these reasons, claims 2-4, 9-11, and 16-18 are fully patentable over Peercy *et al.* and Getchius *et al.*, either alone or in combination. Moreover, certain rejected claims are patentable over the combination of references for the additional reasons disclosed below.

Claims 2, 9, and 16. Claims 2, 9, and 16, as amended disclose that the directed content is a hyperlink to a selected web service. The Examiner states that Peercy *et al.* does not explicitly teach this limitation, but Getchius *et al.* does. The Examiner cites Getchius *et al.*, col. 11, lines 4-12, as teaching a hyperlink to a remote web service as directed content. First, the connection between the request router and a server node is not a hyperlink. By definition, a hyperlink allows access to the content of a link-specified document (i.e., a document whose identity or address is specified by the hyperlink). The connection between the request router and a server node in Getchius *et al.*, however, allows access to a server node and not a link-specified document. Second, Getchius *et al.* does not teach allowing access to a remote web service. Claims 1, 8, and 15, as amended, recite that the selected web service is a remote web service. The server node to which a user request is routed in

Getchius *et al.*, however, is a server node within the query tool itself—not a remote web service.

Claims 3, 10, and 17. Claims 3, 10, and 17, as amended, recite identifying a category corresponding to the selected web service, and then including in the directed content an advertisement corresponding to the identified category. The Examiner states that Peercy *et al.* does not explicitly teach this limitation, but that Getchius *et al.* does. Unlike claims 3, 10, and 17, Getchius *et al.* only discloses relating a user query to a category, and then displaying an advertisement corresponding to that category. In Getchius *et al.*, a user submits a query and an advertisement related to that query is displayed. Getchius *et al.* provides an example in which a user submits a query with the category “art supplies.” The online query tool then displays an advertisement related to art. (Getchius *et al.*, col. 61, lines 39-56.) Getchius *et al.* thus does not recite the intermediate relations from user query to web service, and from web service to category. Claims 3, 10, 17, by using these intermediate relations, can then display an advertisement from a category that is not necessarily directly related to the user query. As such, the combination of Peercy *et al.* and Getchius *et al.* does not disclose the intermediate relations from a user query to a web service, and from a web service to a category as required by claims 3, 10, and 17.

Claims 4, 11, and 18. Claims 4, 11, and 18, as amended, recite routing the query to an instance of the selected remote web service, collecting a response from that web service, and including a portion of that response in a displayed advertisement. The Examiner states that Peercy *et al.* does not explicitly teach such limitations, but that Getchius *et al.* does. In contrast to the routing of a user query to a remote web service, as recited in claims 4, 11, and 18, Getchius *et al.* only routes a user query to a server node within the online query tool itself. (Getchius *et al.*, col. 11, lines 13-27.) The result is that no response can be collected from a remote web service, and, accordingly, a portion of such a response cannot be included in a displayed advertisement.

Thus, for the reasons identified above, the combination of Peercy *et al.* and Getchius *et al.* fails to teach or suggest the limitations of claims 2-4, 9-11, and 16-18. Therefore, Applicants respectfully request that the rejection be withdrawn.

The combination of Getchius *et al.* and Peercy *et al.* does not teach or suggest each limitation of claim 24, 25, 28, and 31.

Claims 24, 25, 28, and 31 ultimately depend from claims 22, 26, and 29. As discussed in the 35 U.S.C. § 102 rejections above, claims 22, 26, and 29 are patentable over Getchius *et al.* because the reference does not teach routing a query and receiving a response from a remote web service or including, in a directed advertisement, a portion of a response generated by a remote web service upon presentation of a query. Peercy *et al.*, which is directed to a modified search engine with a multiple reference hotlist on which frequently retrieved web pages are identified, fails to remedy these deficiencies in Getchius *et al.* Therefore, claims 24, 25, 28, and 31, which include all the limitations of one of claims 22, 26, and 29 are fully patentable over the combination of Getchius *et al.* and Peercy *et al.* Furthermore, claims 24, 25, 28, and 31 are patentable over the combination of Getchius *et al.* and Peercy *et al.* for the reasons disclosed below.

Claim 24. Claim 24, as amended, recites using the Open Directory Project (ODP) as a web resource. The Examiner asserts that the history log database disclosed in Peercy *et al.* serves as the ODP recited in claim 24. This history log database, however, is different from the ODP. The ODP is an online directory of the World Wide Web edited by humans. A user can submit a URL to the ODP based only upon the users' knowledge of the URL. This means that a URL need not have been visited even once to appear in the ODP. In contrast, the history log database is generated based upon actual visits to the URLs through the modified search engine described in Peercy *et al.* In Figure 3 of Peercy *et al.*, block 40 represents the addition of a record for a URL not currently found in the history log database. This occurs when the URL is visited for the first time through the system described in Peercy *et al.*

Claims 25, 28, and 31. The Examiner asserts that the history log database disclosed in Peercy *et al.* serves as the frequency database recited in claims 25, 28, and 31. This history log database, however, is different from the frequency database recited in claims 25, 28, and 31. The frequency database recited in claims 25, 28, and 31 is a database that stores the searches submitted, as well as the web services to which each search was submitted, and the frequency with which each search was submitted to each web service. In contrast, the history log database stores only the URLs visited and the frequency with which each URL was visited. The history log database, unlike the frequency database, does not store the searches

submitted, and thus, does not organize the URLs visited by the searches submitted to find the URLs.

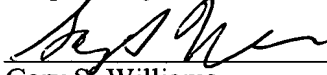
For the reasons discussed above, Applicants respectfully request that the rejection to claims 24, 25, 28, and 31 be withdrawn.

CONCLUSION

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 493-4935, if a telephone call could help resolve any remaining items.

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Respectfully submitted,



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